REMARKS

These Remarks are in reply to the Office Action mailed October 18, 2005. Claims 1-19 and 24-30 are pending. No amendments have been made. Applicants respectfully request reconsideration of claims 1-19 and 24-30.

I. Information Disclosure Statement Filed July 27, 2005

Applicants filed an Information Disclosure Statement (IDS) on July 27, 2005 using the ePAVE system. Attached to this response as Exhibit A is a copy of that Information Disclosure Statement. Attached to this response as Exhibit B is a copy of the receipt received from the United States Patent and Trademark Office acknowledging receipt of the IDS.

Applicants have not received the IDS form from the Examiner, acknowledging that the cited references have been considered in accordance with the requirements of M.P.E.P. § 609. Therefore, Applicant respectfully requests that the Examiner send to Applicant a copy of the initialed from acknowledging that the the cited references have been considered.

II. Summary of Rejections

Claims 1-19, 24-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2003/0084121 ("*DeBoor*"), U.S. Patent No. 6,553,410 ("*Kikinis*") and U.S. Patent No. 6,589,290 *("Maxwell").*

III. Summary of Applicants' Response

Applicants assert that claims 1-18 are patentable under § 103(a) over *DeBoor, Kikinis,* and *Maxwell,* either alone or in combination. Applicants assert that the combination of references fails to teach or suggest each limitation of claims 1-18, and in fact, that the newly cited reference, *Maxwell,* teaches away from these claims.

Applicants assert that claims 19 and 24-30 are patentable under § 103(a) over *DeBoor, Kikinis,* and *Maxwell* because the *Office Action* fails to present a prima facie case of obviousness with respect to these claims. The *Office Action* fails to address the limitations added to claims 19

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and 24 by Applicants' response dated July 27, 2005, and also fails to address the limitations of claims 28-30 which were newly added in that response. Because there is no allegation or showing of a teaching or suggestion of each limitation of these claims, no prima facie case of obviousness has been made. Applicants further assert that *DeBoor, Kikinis,* and *Maxwell,* alone or in combination, fail to teach or suggest each of the limitations of these claims.

IV. Rejection of Claims 1-18

Independent claim 1 recites, among other limitations:

> storing, at said server machine, a template having pre-defined user data for use in performing server actions, wherein the template includes
>> a plurality of fields,
>> attribute data associated with each of the fields, and
>> previously entered user data associated with at least
> one field of said plurality,
>
> ...
>
> if it is not necessary to obtain information to complete the field, then performing the server action without obtaining information from the client machine to complete the field, said *performing the server action without obtaining information from the client machine includes, for the at least one field, using the previously entered user data to complete the at least one field. (Emphasis added).*

As claim 1 recites, "previously entered user data" is stored in a template at a "server machine" so that a "server action" can be performed "without obtaining information from the client machine" by "using the previously entered user data." (*Emphasis added*). The *Office Action* relies upon a newly cited reference, *Maxwell,* after noting that the combination of *DeBoor* and *Kikinis* fails to disclose "performing the server action without obtaining information from the client machine includes, for the at least one field, using the previously entered user data to complete the at least one field." *Maxwell,* however, is directed to an application that "executes on a web client ... capable of obtaining forms from the Internet" and is "configured to allow a user to populate a form with data." *Maxwell,* col. 9, ll. 29-35 (*emphasis added*). Because *Maxwell's* application is a client application that fills out forms at the client where it is located, it is not seen how it could be considered to perform any type of server action "without obtaining information from the client machine," by "using

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the previously entered user data," as recited in claim 1. Moreover, a careful look at the disclosure in *Maxwell* reveals that the reference teaches away from the claimed invention set out in claim 1.

Maxwell's client based approach is explained in a web environment. In Figure 4, "web browser 401 which resides on web client 400 issues a request 410 for web page 415 from web server 450." "Web server 450 responds by <u>sending a copy of web page 415 to web client 400</u>," and "web client 400 uses web browser 401 to display web page 415." *Id.* at col. 6, ll. 49-59 (*emphasis added*). Maxwell describes an embodiment of his form completion program that executes on such a web client. The "web client is capable of <u>obtaining web pages that contain forms</u>" and "contains computer code, such as a form completion program, configured to enable a user to populate a form with data." *Id.* at col. 8, ll. 1-12 (*emphasis added*). The "form completion program interacts with a target application (e.g., a web browser) installed at the web client to provide the user with a mechanism for filling out multiple forms," which can be "displayed to the user via the target application." *Id.* at col. 8, ll. 1-12.

Maxwell's program runs at a client and interacts with a target application at the client to fill out forms that the client has obtained. This client based program cannot be understood to disclose any manner of performing server actions "without obtaining information from the client machine to complete the field," "by using the previously entered user data," as recited in claim 1. The form is located at the client after being obtained from a web server and the "form completion program" runs at this client to fill out the obtained form. *Id.* The only apparent server action involves the web server providing the form to the client and then receiving it back after it has been filled out at the client. The form is not completed at or by the web server. Thus, any action by the web server would be on data received from the client via the form which was completed at the client. Accordingly, *Maxwell* does not teach or suggest that "performing the server action without obtaining information from the client machine includes, for the at least one field, using the previously entered user data to complete the at least one field," as recited in claim 1.

The Office Action gives weight to *Maxwell's* disclosure that it is "possible to obtain data from other sources" to populate the form at the client. *Id.* at col. 11, ll. 38-44. *Maxwell* explains that the "data population command may obtain data from a memory device that is available via a

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communication medium such as a computer network." *Id.* But whether the data in *Maxwell* is originally stored at the client device or retrieved from somewhere else, it is eventually used (and would appear at least temporarily stored) at the client in order to fill out the form which the web client has obtained. *Maxwell* makes clear that the "data population command may <u>obtain</u> data from a memory device that is available via a communication medium." *Id. (emphasis added)*. Thus, whether the data utilized to populate the form is stored locally or remotely, it must be obtained by the client to fill out the form that the client has obtained. Any subsequent action by the web server would be on data submitted from the client to the server via the form. Accordingly, it cannot be seen how such client based actions could be regarded as a server action performed "without obtaining information from the client machine," by "using the previously entered user data" which is stored at the server machine as recited in claim 1.

A closer inspection of *Maxwell* reveals that it teaches away from Applicants' claim 1. In discussing the deficiencies of the prior art, *Maxwell* notes that a "problem with using CGI (Common Gateway Interface) programs is that since they are located on the server, information cannot easily be saved on the web client for later use." *Id.* at col. 6, ll. 3-5. *Maxwell* further notes that "existing mechanisms for processing forms reside on the server and are unable to populate a form on the client with user data from users that have never visited the web site having the form." *Id.* at col. 6, ll. 6-10. The clear indication from *Maxwell* is that server side solutions have associated problems and that its client based approach is preferable over these.

Applicants, on the other hand, provide a server based solution, reciting in claim 1 that "performing the server action without obtaining information from the client machine includes, for the at least one field, using the previously entered user data to complete the at least one field." *Maxwell* teaches away from this concept by teaching that server based solutions are inferior. Maxwell specifically teaches his client based technique that utilizes data stored and/or received at the client as a better solution than server side techniques. Thus, *Maxwell* teaches away from the combination recited in claim 1.

Because *Maxwell* fails to teach or suggest, and in facts teaches away from, the above-identified limitation, the combination formed by *DeBoor, Kikinis,* and *Maxwell* fails to teach or

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suggest each limitation of claim 1. If *Maxwell* is combined with *DeBoor* and *Kikinis*, the combination would at most teach or suggest a client side solution to fill out a form located at a client machine. There is no teaching or suggestion within any reference individually, of the combination thereof, that "performing the server action without obtaining information from the client machine includes, for the at least one field, using the previously entered user data to complete the at least one field," as recited in claim 1.

Because *DeBoor, Kikinis*, and *Maxwell*, either alone or in combination, fail to teach or suggest each of the limitations of claim 1, Applicants assert that claim 1 is patentable over the cited art under § 103(a). Claims 2-18 each ultimately depend from claim 1 and therefore, should be patentable for at least the same reasons.

V.   Rejection of Claim 19

Because the *Office Action* fails to present a prima facie case of obviousness under 35 U.S.C. § 103(a) against claim 19, Applicants assert that claim 19 is patentable and in condition for allowance. Furthermore, because the combination of *DeBoor, Kikinis*, and *Maxwell* fails to teach or suggest each of the limitations of claim 19, Applicants assert that these claims are patentable over the cited art and in condition for allowance.

The *Office Action* erroneously asserts that claim 19 "has the same limitation as to claim 1 therefore under the same circumstances claim 19 can be rejected." *Office Action*, p. 8. This is incorrect. Independent claim 19 includes distinct limitations from those of claim 1. It is noted that Applicants amended claim 19 in their response dated July 27, 2005. Claim 19 now recites that "each of said templates includes a plurality of fields previously indicated to be editable or non-editable by a user defining said template," as well as "providing at least one edit page from said server machine to said client machine for each field indicated to be editable by said user defining said template." These limitations are not found in claim 1 and do not appear to have been considered and given weight in determining patentability.

The *M.P.E.P.* is unequivocal in its instructions that "[a] plurality of claims should <u>never be grouped together</u> in a common rejection, unless that rejection is equally applicable to all claims in

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the group." *M.P.E.P.* § 707.07(d) (*emphasis added*). In the present case, the rejection of claim 1 is not equally applicable to claim 19 because claim 19 clearly recites limitations not found in claim 1. Thus, the grouping is improper. Moreover, by failing to address each limitation of claim 19, the Examiner has failed to present a prima facie case of obviousness against claim 19. Under 35 U.S.C. § 103(a), the Examiner has the burden of showing a teaching or suggestion of <u>each claim limitation</u> in order to present a prima facie case of obviousness. *See M.P.E.P.* § 2142 ("The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness"); *see also M.P.E.P.* § 2143.03 ("When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight"). Because the Examiner has not made such a showing, or even attempted to address the distinct claim limitations of claim 19, no prima facie case of obviousness has been made. The Examiner is therefore respectfully requested to withdraw the improper rejection of claim 19.

Although there is no requirement that Applicants submit evidence of nonobviousness in light of this improper rejection, Applicants further assert that the combination of references fails to teach or suggest each of the limitations of claim 19 in order to expedite issuance of a patent. *See M.P.E.P.* § 2142 ("If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness"). Applicants direct the Examiner to their Response dated July 27, 2005 (specifically pages 11-13) in which the patentability of claim 19 over *DeBoor* and *Kikinis* under § 103(a) was discussed. That discussion is expressly incorporated herein by reference. Applicants clearly explained the failure of the combination of *DeBoor* and *Kikinis* to teach or suggest the limitations quoted above. Applicants further assert that the combination formed by adding *Maxwell* fails to teach or suggest these limitations. There is nothing in *Maxwell*, or the combination formed with *DeBoor* and *Kikinis*, that relates to templates including "a plurality of fields previously indicated to be editable or non-editable by a user defining said template," or to "providing at least one edit page from said server machine to said client machine for each field indicated to be editable by said user defining said template," as recited in claim 19. Thus, the combination of *DeBoor*, *Kikinis*, and *Maxwell* fails to teach or suggest each of the limitations of claim 19.

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Because no prima facie case of obviousness against claim 19 has been presented, and further, because *DeBoor, Kikinis,* and *Maxwell* fail to teach or suggest each of the limitations of claim 19, Applicants assert that claim 19 is patentable over the cited art.

VI. Rejection of Claims 24-27

Because the *Office Action* fails to present a prima facie case of obviousness under 35 U.S.C. § 103(a) against claims 24-27, Applicants assert that these claims are patentable and in condition for allowance. Furthermore, because the combination of *DeBoor, Kikinis,* and *Maxwell* fails to teach or suggest each of the limitations of claims 24-27, Applicants assert that these claims are patentable over the cited art and in condition for allowance.

In paragraph 21 on pages 8-9 of the *Office Action*, the Examiner sets out the rejection of claim 24 but omits key limitations that were added in Applicants' Response dated July 27, 2005. Specifically, the Examiner does not address the limitations that "said template is at least one of a message generation template, an appointment scheduling template, and a database query submission template." It does not appear that these limitations have been considered and given weight in determining patentability.

By not addressing each limitation of claim 24, the Examiner has not met the burden of showing a teaching or suggestion of each claim limitation in order to present a prima facie case of obviousness under 35 U.S.C. § 103(a). Because no prima facie case of obviousness has been made, the Examiner is respectfully requested to withdraw the improper rejection of claim 24. Claims 25-27 each ultimately depend from claim 24. Therefore, a prima facie case of obviousness has not been presented for these claims for the same reasons. The Examiner is further requested to withdraw the improper rejection of claims 25-27.

Applicants also assert that claims 24-27 are patentable over the cited art under 35 U.S.C. 103(a) because the combination of references fails to teach or suggest each limitation of these claims. Applicants direct the Examiner to their Response dated July 27, 2005 (specifically pages 13-14) in which the patentability of claim 24 over *DeBoor* and *Kikinis* under § 103(a) was discussed. That

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discussion is expressly incorporated herein by reference. In that Response, Applicants clearly explained the failure of the combination of *DeBoor* and *Kikinis* to teach or suggest the limitations quoted above. Applicants further assert that the combination formed by adding *Maxwell* fails to teach or suggest these limitations. There is nothing in *Maxwell*, or the combination formed with *DeBoor* and *Kikinis*, that teaches or suggests "a message generation template," "an appointment scheduling template," or "a database query submission template," as recited in claim 24. Thus, the combination of *DeBoor, Kikinis,* and *Maxwell* fails to teach or suggest each of the limitations of claim 24.

Because no prima facie case of obviousness against claim 24 has been presented, and further, because the combination of *DeBoor, Kikinis,* and *Maxwell* fails to teach or suggest each of the limitations of claim 24, Applicants assert that claim 24 is patentable over the cited art. Claims 25-27 each ultimately depend from claim 24 and therefore, should be patentable for at least the same reasons.

VII. Rejection of Claims 28-30

Because the *Office Action* fails to present a prima facie case of obviousness under 35 U.S.C. § 103(a) against claims 28-30, Applicants assert that these claims are patentable and in condition for allowance. Furthermore, because the combination of *DeBoor, Kikinis,* and *Maxwell* fails to teach or suggest each of the limitations of claims 28-30, Applicants assert that these claims are patentable over the cited art and in condition for allowance.

Claims 28-30 were added in Applicants' Response dated July 27, 2005. In paragraph 3 on pages 2-5 of the *Office Action*, the Examiner groups claim 28 with the rejection of claim 1. This grouping is improper as claim 28 includes distinct limitations from claim 1. Among other limitations, claim 28 recites:

> receiving first user input to create a user-defined template
> including a first plurality of fields and pre-defined data for at least
> one of said first plurality of fields, *said first user input indicates*
> *whether each of said first plurality of fields is an editable field or a*
> *non-editable field*;
> receiving a request from a client machine to perform a first

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server action using said template, said first server action requires user input for *a second plurality of fields corresponding to said first plurality of fields of said template*; providing at least one edit page from said server machine to said client machine to receive information for each field in said first plurality of fields indicated to be an editable field by said first user input, said at least one edit page is provided *for less than all of said second plurality of fields requiring user input for said first server action.* (*Emphasis added*).

The limitations of claim 28 highlighted above in italics do not appear to have been considered and given weight in determining patentability. Thus, the Examiner has not met the burden of showing a teaching or suggestion of each claim limitation in order to present a prima facie case of obviousness under 35 U.S.C. § 103(a). Because no prima facie case of obviousness has been made, the Examiner is respectfully requested to withdraw the improper rejection of claim 28. Claims 29-30 each ultimately depend from claim 28. Therefore, a prima facie case of obviousness has not been presented for these claims for the same reasons. The Examiner is further requested to withdraw the improper rejection of claims 29-30.

Applicants further assert that claims 28-30 are patentable over the cited art under 35 U.S.C. 103(a) because the combination of references fails to teach or suggest each limitation of these claims. Applicants direct the Examiner to their Response dated July 27, 2005 (specifically pages 14-16) in which the patentability of claim 28 over *DeBoor* and *Kikinis* under § 103(a) was discussed. That discussion is expressly incorporated herein by reference. In that Response, Applicants clearly explained the failure of the combination of *DeBoor* and *Kikinis* to teach or suggest the limitations quoted above.

Applicants further assert that the combination formed by adding *Maxwell* fails to teach or suggest these limitations. For example, there is nothing in *Maxwell*, or the combination formed with *DeBoor* and *Kikinis*, that teaches or suggests "receiving first user input to create a user-defined template including a first plurality of fields" where the first user input "indicates whether each of said first plurality of fields is an editable field or a non-editable field." Likewise, there is nothing in *Maxwell*, or the combination formed with *DeBoor* and *Kikinis*, that teaches or suggests "providing at

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least one edit page from said server machine to said client machine to receive information for each field in said first plurality of fields indicated to be an editable field by said first user input, said at least one edit page is provided for less than all of said second plurality of fields requiring user input for said first server action."

Because no prima facie case of obviousness against claim 28 has been presented, and further, because the combination of *DeBoor, Kikinis,* and *Maxwell* fails to teach or suggest each of the limitations of claim 28, Applicants assert that claim 28 is patentable over the cited art. Claims 29-30 each ultimately depend from claim 28 and therefore, should be patentable for at least the same reasons.

VIII. <u>Conclusion</u>

Based on the above amendments and these remarks, reconsideration of claims 1-19 and 24-30 is respectfully requested.
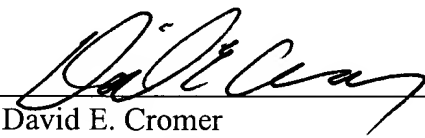
The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, April 18, 2006.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: _April 18, 2006_   By: _____
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